

### **Remarks/Arguments**

#### **I. Status of the Claims**

Claims 11-26 are under examination in the instant application.

Claims 15-26 remain withdrawn from consideration.

Claim 14, 17 and 26 stand rejected under 35 U.S.C. § 102(b).

Claims 11-12, 14, 17 and 26 stand rejected under 35 U.S.C. § 103(a).

Claims 11-14, 16-17, 19 and 23-26 are currently canceled.

Claim 22, although withdrawn, is currently amended to include the Markush group of PDEV inhibitors found on, for example, the specification section bridging page 28, lines 31-34 through page 29, lines 5-6.

No new matter is introduced by these amendments.

#### **II. Request for Rejoinder of Claims 15, 18 and 20-22, and New Claims 27, 28 and 29**

Claims 15-26 are currently withdrawn from consideration. It is respectfully submitted that claims 15, 18 and 20-22 are consistent with the examination of compounds of formula (1b), and therefore should be rejoined. Indeed, the elected compound (2*S*,4*S*)-4-(3-Fluoro-benzyl)-pyrrolidine-2-carboxylic acid falls within formula I(b), as claimed in claims 15, 18, 20-22 and new claim 27. Claims 27, 28 and 29 are individual compounds claims as recited in the Markush claim 18, written in independent form. Each of these compounds is exemplified in the instant specification, for example at page 51 (Example 10), page 52 (Example 11), and pages 52-53 (Example 12). Therefore, no new matter is interposed by the new claims. In addition, new claim 27 recites (2*S*,4*S*)-4-(3-Fluoro-benzyl)-pyrrolidine-2-carboxylic acid, the species elected for purposes of examination. In the paper submitted on February 24, 2006, applicants elected group II, compounds and pharmaceutical compositions, of claims 9-13, and elected (2*S*,4*S*)-4-(3-Fluoro-benzyl)-pyrrolidine-2-carboxylic acid for purposes of examination. New claims 14-26 were added, and were consistent with the election of the compound and pharmaceutical composition claims. It is believed that the Examiner's withdrawal of claims 15-26 was therefore improper, and it is respectfully requested that the current claims 15, 18, 20-22 and 27-29 be entered and examined.

**III. Rejection under 35 U.S.C. § 102(b)**

Claims 14, 17 and 26 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,385,889, Kyle et al. 1995 (the '889 patent).

While applicants still maintain that Kyle et al. does not anticipate the present invention, in the interest of expediting prosecution, claims 14, 17 and 26 have been cancelled, without prejudice to applicants right to re-file the subject matter of claims 14, 17 and 26 in one or more continuing applications.

**IV. Rejection under 35 U.S.C. § 103(a)**

Claims 11-12, 14, 17 and 26 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kyle et al., US 5,385,889 (the '889 patent).


While applicants still maintain that Kyle et al. does not render the present invention obvious, in the interest of expediting prosecution, claims 11-12, 14, 17 and 26 have been cancelled, without prejudice to applicants right to re-file the subject matter of claims 11-12, 14, 17 and 26 in one or more continuing applications.

**V. Conclusion**

For all of the above reasons, reconsideration and withdrawal of the rejections under 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a) is respectfully requested, and allowance of claims 15, 18, 20-22 and new claims 27-29 is solicited.

If the Examiner believes a telephonic interview with Applicant's representative would aid in the prosecution of this application, the Examiner is cordially invited to contact Applicant's representative at the below listed number.

Respectfully submitted,



Philip B. Polster II  
Attorney for Applicants  
Reg. No. 43,864  
PHARMACIA CORPORATION  
Corporate Patent Law Department  
314-274-9094 (St. Louis)